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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,289	11/20/2001	Jason Norman Morrow	30879.238175	9536

60601 7590 05/02/2007
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EXAMINER

ESTRADA, ANGEL R

ART UNIT	PAPER NUMBER
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2831

MAIL DATE	DELIVERY MODE
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05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Office Action Summary</p>	Application No. 09/989,289	Applicant(s) MORROW ET AL.	
	Examiner Angel R. Estrada	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35,42-53,57-60,68-70,75-79,94-96,98,100-105,113-115 and 128-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57-60 is/are allowed.
- 6) ☒ Claim(s) 35,42-44,49-53,113,128 and 133-138 is/are rejected.
- 7) ☒ Claim(s) 45-48,68-70,75-79,94-96,98,100-105,114,115 and 129-132 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) *
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) *
Paper No(s)/Mail Date <u>2/5/07</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____ |
|--|--|

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 5, 2007 has been considered by the Examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 35, 42-44, 49-53, 113, 128 and 133-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergemann (DE 2,248,441) in view of Pelzer (US 5,212,349).

Regarding claim 35, Bergemann discloses a toneable conduit (see figure 1), comprising: an elongate polymeric tube having a wall with an interior surface and an exterior surface (see figure 1); and a stabilizing rib (see figure 1) extending longitudinally along the interior surface of the wall of the elongate polymeric tube; and a continuous wire (B) coincident with the channel in the elongate polymeric tube and having sufficient strength (since is a metallic wire) to tear through the conduit (since is a plastic conduit); said wire (B) capable of transmitting a toning signal to allow the conduit to be detected by toning equipment (see abstract); but Bergemann lacks a channel extending longitudinally within the wall of the elongate polymeric tube. Pelzer teaches a toneable conduit (16) comprising an elongated polymeric tube, a channel (see figure 7) extending longitudinally within the wall of the elongate polymeric tube (16) and a continuous wire (14) coincident with the channel in the elongated polymeric tube (see figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the toneable conduit with a channel extending longitudinally within the wall of the elongate polymeric tube as taught by Pelzer to protect the wire against corrosion.

Regarding claim 42, Bergemann discloses the claimed invention except for the wire being selected from the group consisting of copper-clad steel wire, copper-clad aluminum wire, copper wire, and tin copper wire. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the wire from the group consisting of copper-clad steel wire, copper-clad aluminum wire, copper wire, and tin copper wire, since it has been held to be within the general skill of a worker in

the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 43, Bergemann discloses the claimed invention except for the wire being copper-clad steel wire. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wire as copper-clad steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 44, Bergemann discloses the claimed invention except for the wire having a diameter of from about 0.32mm to about 2.59 mm. It would have been an obvious matter of design choice to make the wire having a diameter of from about 0.32mm to about 2.59 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 49, Bergemann discloses the toneable conduit (see figure 1), wherein said elongate tube has a predetermined wall thickness (see figure 1).

Regarding claim 50, Bergemann discloses the toneable conduit (see figure 1), wherein the exterior surface of the tube is smooth (see figure 1).

Regarding claim 51, Bergemann discloses the claimed invention except for said elongate polymeric tube being formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride. It would have been obvious to one

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having ordinary skill in the art at the time the invention was made to make the elongate polymeric tube from a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 52, Bergemann discloses the claimed invention except for said elongate polymeric tube being formed of high density polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the elongate polymeric tube formed of high density polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 53, Bergemann discloses the claimed invention except for the toneable conduit, further comprising at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an additional rib extending longitudinally along the interior surface of the elongate polymeric tube, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regarding claim 113, Bergemann discloses the toneable conduit (see figure 1), wherein the stabilizing rib (see figure 1) is integral with the elongate polymeric tube (see figure 1).

Regarding claim 128, Bergemann discloses the claimed invention except for the wire having a diameter of from about 0.32 mm to about 2.59 mm. It would have been an obvious matter of design choice to make the wire having a diameter of from about 0.32mm to about 2.59 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 133, Bergemann discloses the toneable conduit (see figure 1), wherein said elongate tube has a predetermined wall thickness (see figure 1).

Regarding claim 134, Bergemann discloses the toneable conduit (see figure 1), wherein the exterior surface of the tube is smooth (see figure 1).

Regarding claim 135, Bergemann discloses the claimed invention except for said elongate polymeric tube being formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the elongate polymeric tube from a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the

intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 136, Bergemann discloses the claimed invention except for said elongate polymeric tube being formed of high-density polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the elongate polymeric tube formed of high density polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 137, Bergemann discloses the claimed invention except for the toneable conduit, further comprising at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an additional rib extending longitudinally along the interior surface of the elongate polymeric tube, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regarding claim 138, Bergemann discloses the toneable conduit (see figure 1), wherein the stabilizing rib (see figure 1) is integral with the elongate polymeric tube (see figure 1).

Allowable Subject Matter

3. Claims 57-60 are allowed.

Claims 45-48, 68-70, 75-79, 94-96, 98, 100-105, 114,115 and 129-132 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 45-48, 57-60, 98, 100 and 129-132 are:

Regarding claims 45-48, 68-70, 75-79, 94-96, 98, 100-105, 114 and 115, the prior art does not teach or fairly suggest in combination with the other claimed limitations a toneable conduit, wherein said wire is coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube.

Regarding claims 57-60, the prior art does not teach or fairly suggest in combination with the other claimed limitations a method of coupling a first toneable conduit with a second comprising the steps of tearing the wire of the first toneable conduit through the exterior surface of the first toneable conduit; tearing the wire of the second toneable conduit through the exterior surface of the second toneable conduit; mechanically connecting the first conduit and second conduit; and electrically connecting the wire from the first toneable conduit and the wire from the second toneable conduit.

Regarding claims 129-132, the prior art does not teach or fairly suggest in combination with the other claimed limitations a toneable conduit, wherein said wire is coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube.

These limitations are found in claims 45-48, 57-60, 68-70, 75-79, 94-96, 98, 100-105, 114, 115 and 129-132 are neither disclosed nor taught by the prior art of record, alone or in combination.

Response to Arguments

4. Applicant's arguments with respect to claims 35, 42-44, 49-53, 113, 128 and 133-138 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pelzer (US 5,415,242) and Watts et al (US 6,933,438) discloses a toneable conduit.

6. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 Ext: 31. The fax phone

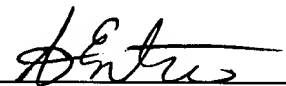
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 27, 2007



Angel R. Estrada
Primary Examiner
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